

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD HAYTON and DAVID HALLS

Appeal 2007-1646
Application 09/704,896
Technology Center 2100

Decided: August 28, 2007

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3-11, 13-15, 17, and 18. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and apparatus for incorporating a partial page on a client. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for incorporating a dynamic portion of a transmitted page into a previous version of the transmitted page displayed on a client, the method comprising:
 - (a) receiving, at a client, a transmitted page comprising a plurality of dynamic portions;
 - (b) displaying the transmitted page on the client;
 - (c) receiving, by the client, a modified version of one of the dynamic portions of the page and an identifier specifying one of the plurality of dynamic portions of the transmitted page to be replaced by the modified version of one of the dynamic portions; and
 - (d) incorporating, by the client, the modified version of one of the dynamic portions into the transmitted page displayed on the client responsive to the modification list.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Nazem	US 5,983,227	Nov. 9, 1999
Jeyaraman	US 6,311,187 B1	Oct. 30, 2001

REJECTIONS

Claims 1, 3-11, 13-15, and 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nazem in view of Jeyaraman.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed December 11, 2006) for the reasoning in support of the rejection, and to Appellants' Brief (filed September 27, 2006) and Reply Brief (filed February 12, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) objective indicia of non-obviousness.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966)).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

Leapfrog Enter., Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

Discussing the question of obviousness of a claimed combination of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. AG Pro, Inc.*, 425 U.S. 273, 189 USPQ 449 (1976)] and *Anderson's-Black Rock* [*Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Where, on the other hand, the claimed subject matter involves more than the simple substitution, one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness must be based on “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. That is, “there must be some articulated reasoning with some rational underpinning

to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, it is not necessary to look only to the problem the patentee was trying to solve; “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added).

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. *See also Leapfrog*, 485 F.3d at 1162, 82 USPQ2d at 1691 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John*

Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336). Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited and disputed in independent claim 1.

Appellants argue that neither applied reference to Nazem and Jeyaraman teaches receiving only a modified portion of a page from a server and replacing the dynamic portion of the page with the received modified dynamic portion of the page (Reply Br. 2-3). While we agree with Appellants that neither reference teaches or fairly suggests receiving only a modified dynamic portion of a page from a server and replacing the dynamic portion of the page with the received modified portion of the page, we note that this is not the express language of independent claim 1.

Specifically, independent claim 1 recites:

- (c) receiving, by the client, a modified version of one of the dynamic portions of the page and an identifier specifying one of the plurality of dynamic portions of the transmitted page to be replaced by the modified version of one of the dynamic portions; and
- (d) incorporating, by the client, the modified version of one of the dynamic portions into the transmitted page displayed on the client responsive to the modification list.

While the express language of independent claim 1 is slightly different than that argued by Appellants, we agree with Appellants' basic premise that neither reference teaches nor fairly suggests the use of the dynamic portion(s) of a transmitted page and then receiving at least a modified dynamic portion and incorporating the modified portion into the transmitted page. We agree with Appellants that the page with live data taught by Nazem does not have dynamic portions that are modified at the client (rather than at the server) and then transmitted to the client. While the Examiner maintains that Jeyaraman teaches modified portions of dynamic portions (Answer 4-5 and 11-12), we do not find that those sections of Jeyaraman relied upon by the Examiner clearly support the Examiner's contention that modified dynamic portions are incorporated into previously transmitted and received pages. Therefore, we find that the Examiner has not set forth a prima facie case of obviousness since the Examiner has not shown all the recited claim elements are taught or fairly suggested by Nazem and Jeyaraman. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 3-10.

We find similar limitations in independent claims 11 and 15, and similarly find the Examiner's initial showing deficient. Therefore, we will not sustain the Examiner's rejection of independent claims 11 and 15 and their dependent claims 13, 14, 17, and 18.

CONCLUSION

To summarize, we have not sustained the rejection of claims 1, 3-11, 13-15, 17, and 18 under 35 U.S.C. § 103(a).

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REVERSED

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